

REMARKS

Prior to the present response, claims 1-3, 5-11 and 13-17 were pending. By way of the above amendments, claim 1 has been amended and claims 10, 11 and 17 have been canceled without prejudice or disclaimer. Accordingly, claims 1-3, 5-9 and 13-16 currently are pending.

Claim 1 has been amended to recite that the controller operates to driving the taking lens to a focus position where in-focus condition is substantially obtained for distant to close-range views when power supply to the camera is started. Support for this amendment is found, for example, in the specification, at page 19, line 26 to page 20, line 11 and lines 19-23, page 23, lines 7-11, and in Figure 7.

In light of the above amendment and the following remarks, Applicants respectfully request reconsideration and withdrawal of the rejections of the claims.

Summary of the Proceedings

In a first-issued Office Action dated May 22, 2003, claims 4, 7-9, 11-13, 15 and 16 were rejected under 35 U.S.C. § 102 as allegedly being anticipated by the Toyofuku patent (U.S. Patent No. 6,166,765), claims 1-3, 5, 6 and 14 were rejected under 35 U.S.C. § 103, as allegedly being unpatentable over combinations of the Toyofuku patent Hamada et al. patent (U.S. Patent No. 5,819,120), and claim 10 was rejected under 35 U.S.C. § 103, as allegedly being unpatentable over the Toyofuku patent in view of the Isoguchi et al. patent (U.S. Patent No. 4,963,985). In response to the first Office Action, Applicants filed an Amendment on September 15, 2003, in which Claims 5 and 14 were rewritten in independent form to respectively include all the features of original independent claims 4 and 12, claims 4 and 12 were canceled without prejudice or disclaimer, claims 7, 11, 13 and 15 were amended to conform their dependencies to one of independent claims 5, 10, and 14, and a new independent claim 17 was added. In Applicants' response, the rejections of all pending claims, including independent claims 1, 5, 10 and 14, were traversed.

On December 5, 2003, the Office issued a final Office Action in which the Examiner maintained the rejections of claims 1-3, 5, 6 and 14 and rejected claim 17 under 35 U.S.C. § 103 based on combinations of the Hamada et al. and Toyofuku patents, and maintained the Section 103 rejection of claim 10 based on the Toyofuku and Isoguchi et al. patents. In

response, Applicants submitted an Amendment After Final Rejection on March 31, 2004, which included an amendment to independent claim 1 to correct a minor typographical error and presented arguments traversing the outstanding final rejections.

On April 30, 2004, the Office issued an Advisory Action (Paper No. 11), which indicated that the Amendment After Final Rejection would be entered and that the rejections of independent claims 1, 5, 10, 14, 16 and 17 would be maintained. Applicants hereby request that the Amendment After Final Rejection be entered and considered (if not already entered).

After receiving the Advisory Action, a personal interview with Examiner Villecco and his supervisor, Primary Examiner Wendy Garber, was scheduled for May 24, 2004, to discuss the final rejections. However, on the day of the interview, a scheduling matter prevented Ms. Garber from attending. Primary Examiner Andrew Christensen attended in her place. Several arguments were presented by the undersigned to the attending examiners, which concerned why the rejection failed to establish a *prima facie* case of obviousness. In addition, because a Notice of Appeal had been filed for the application, the undersigned requested confirmation that the final rejection would be maintained in light of the rejections discussed, before proceeding further along the lines of an appeal. However, Mr. Christensen indicated that he was not familiar with the application and that the items discussed in the interview would be brought to the attention of Ms. Garber for decision. On June 2, Examiner Villecco telephonically contacted the undersigned and indicated that Ms. Garber had decided to maintain the outstanding rejections.

In the present Amendment, independent claim 1 has been amended and claims 10, 11 and 17 have been canceled without prejudice or disclaimer. Applicants respectfully request the Examiner to reconsider the rejections of the claims in light of the following remarks, because each of the rejections fail to establish a *prima facie* case of obviousness, as required under 35 U.S.C. § 103.

**The Hamada et al. and Toyofuku Patents Do Not
Teach or Suggest All Claim Limitations**

The December 5, 2003 final Office Action includes rejections under Section 103 of independent claims 1, 5, 14 and 16, as allegedly being unpatentable over various

combinations of the Hamada et al. and Toyofuku patents. These rejections are respectfully traversed. The cited documents must teach or suggest all of the claim limitations to establish a *prima facie* case of obviousness (see, MPEP § 2143). It is respectfully submitted that the rejections in the final Office Action cannot stand because the Hamada et al. and Toyofuku patents fail to teach the combinations of each and every feature recited in the pending independent claims, regardless of whether these patents are considered individually or in any combination thereof.

Amended independent claim 1 and independent claim 5 each are directed to a camera that comprises, *inter alia*, a controller for driving a taking lens to a focus position where in-focus condition is substantially obtained for distant to close-range views when power supply to the camera is started. It is respectfully submitted that this feature set forth in each of independent claims 1 and 5 recites a common distinction that is neither taught nor suggested in the proposed combinations of the Hamada et al. and Toyofuku patents.

In connection with this claimed subject matter, the final Office Action acknowledges that the Hamada patent does not disclose moving a lens to an in-focus state. The Action goes on to assert that because Hamada teaches to move a lens to a frequently used focal length upon power-up of the camera, that “[t]his insinuates that the camera is tracking focal lengths of each of the images taken by the user, and driving the lens to a position that is very close to an in-focus position.” (See the final Office Action, page 2, section 3, lines 11-12.) As pointed out in Applicants’ Amendment After Final Rejection, however, independent claim 5 does not merely recite “a position that is very close to an in-focus position,” as alleged in the Office Action. Rather, claim 5, as well as amended independent claim 1, recite, among other features, that an in-focus condition is substantially obtained *for distant to close-range views when power supply to the camera is started*. That is, an in-focus condition is substantially obtained for *any view* in the claimed span of distant to close-range views *when power supply to the camera is started*. Applicants respectively reiterate that the Hamada patent does not teach or suggest such a feature.

The Hamada et al. patent, by contrast, is concerned with automatically moving a lens to a spatial position having a focal length that might be closer to a desired *focal length* that would be set when photographing an object. Hamada’s reason for doing this is to adjust the lens of the camera at a desired *width of field* for photographing more quickly, without

confusing the user during photographing. (See column 1, lines 33-47.) The initial lens position in Hamada et al., therefore, appears to only concern spatial *proximity* of the lens, when positioned at the initial position, to a usually desired *focal length* (and corresponding width of field) for composing a photograph so that the user sees a familiar field of view close to where the user usually shoots. The Hamada et al. patent, however, does not teach *focusing* by way of such lens movement. Rather, it discloses how to control the *focal length* of a zoom lens when the main switch of a silver-halide-film camera is turned on. (See column 4, lines 40-46; column 7, lines 23-27; and column 8, lines 11-18.)

It is to be noted that the April 30, 2004 Advisory Action includes the statement "Hamada is used to disclose the driving of a lens to a usable position upon powerup" (see page 2, lines 7-8). However, to the extent that Hamada et al. describes driving a variable focus lens to a "usable position" (it appears that the Examiner is referring here to what is called in Hamada et al. an "initial condition"), disclosure of any "usable position" in Hamada et al. concerns only *focal length* and not an in-focus condition as claimed.

Furthermore, the Hamada et al. patent does not mention anything with respect to a display for displaying a subject image, as recited in independent claims 1 and 5. Hence, it is respectfully submitted that the Hamada patent is not concerned with solving problems concerning the display of the subject image when power supply to a camera is started. In contrast, the present invention reduces instances of blur in a camera display when power is supplied to the camera is started (e.g., see Applicants' specification, page 2, lines 11-12, page 19, lines 26, line 26 to page 20, line 3). Hamada's disclosure of moving a lens to an initial position of frequently used focal length does not address these problems, and more significantly, does not disclose what is recited in independent claims 1 and 5.

With respect to the Toyofuku patent, the Advisory Action includes the statement: "In column 16, lines 5-7 of Toyofuku, when a photography mode is selected and an LCD switch is on, the lens is driven to a pan focus position." However, this lens driving event in Toyofuku does not occur *when power supply to the camera is started*. For instance, column 14, lines 54-61 of the Toyofuku patent describe a barrier 52 on the face of the camera 51 that is movable to slide to a closed position or open position at which the photographic lens 31 is closed or open. According to Toyofuku, a barrier switch 65 in the camera is turned on or off in response to the opening or closing movement of the barrier. When switch 65 is turned on,

an output signal is input to the system controller 66 for controlling drive given by the motor or electromagnet. The output of the barrier switch 65 is checked to see if the barrier is open, and if so, the state of the LCD switch 58 is checked (see column 15, lines 50-55). If the LCD switch 58 is not pushed in this state, the camera waits for pressing the release button while the LCD is off (see column 15, lines 56-59). Hence, in the photographing mode of Toyofuku's camera, power is already being supplied to the camera regardless of whether the LCD monitor is switched on or off. Because the "pan focusing position" described in Toyofuku is achieved only after pressing the LCD switch 58 when in the photographing mode (see Figure 24, steps S18 and S19, and column 15, lines 54-55 and column 16, lines 5-7), driving the taking lens is not performed *when power supply is started*. Therefore, even if one were to consider, for the sake of argument, that the pan focusing position of Toyofuku were to correspond to an in-focus condition is substantially obtained for distant to close-range views, the Toyofuku patent would not have taught or suggested a controller that operates to drive a taking lens to this pan focusing position *when power supply to the camera is started*.

On page 3, line 1, the final Office Action states "Toyofuku is used to show the limitation of driving a lens to an in-focus state." However, as pointed out above, the pan position described in the Toyofuku patent occurs only after pressing and holding the LCD switch 58 while the camera is already in a state of being supplied power. Moreover, Toyofuku discloses that when the camera is started, the lens is reset to a reset position. (See column 7, lines 39-42, column 15, lines 49-51 and Figures 12 and 24.) Hence, the Toyofuku patent does not teach or suggest a controller for moving a lens to an in-focus position for distant to close-range views *when power supply to the camera is started*, as set forth in independent claims 1 and 5.

Hence, neither Hamada nor Toyofuku teach or suggest the claimed features of a controller for driving the taking lens to a focus position where in-focus condition is substantially obtained for distant to close-range views when power supply to the camera is started, as recited in each of independent claims 1 and 5.

Despite the deficiencies noted above for the Hamada and Toyofuku patents, page 3, lines 1-4 of the final Office Action states that it would have been obvious to move the lens to an in-focus position upon startup so that, if requested, an image can be displayed as soon as the camera is powered up. Additionally, the Advisory Action states: "When [Hamada's

disclosure is] used in conjunction with Toyofuku, one of ordinary skill in the art would have found it obvious to drive the lens of Hamada to a pan focus position upon powerup.” It is respectfully submitted, however, that these conclusions are neither based in any factual evidence from the applied references nor from any knowledge generally available to one of ordinary skill in the art. Hence, even if one were to consider, *arguendo*, that of ordinary skill in the art were to be led to combine the Hamada et al. and Toyofuku patents, such combination would not have taught or suggested the combinations of features set forth in independent claims 1 and 5. As such, the rejections of these claims fail to establish a *prima facie* case of obviousness. Moreover, because the motivation for the proposed modification is not found in the prior art, it is respectfully submitted that the Examiner's reasoning used to arrive at his conclusions can only be based hindsight vision gleaned after having viewed Applicant's own disclosure. Hindsight reasoning, of course, is impermissible and cannot be a basis for establishing a *prima facie* case of obviousness.

For at least these reasons, the rejections fail to establish a *prima facie* case of obviousness. Accordingly, the rejections under Section 103 should be withdrawn.

Claims 6-9 depend from claim 5 and are therefore allowable for the above reasons, and further for the additional features recited.

It is respectfully submitted that distinctions similar to those recited in claim 5 are recited in each of independent claims 14 and 16. For instance, claim 14 recites “a controller for controlling image taking so that *in-focus condition is substantially obtained for distant to close-range views* before display by the display device is started, wherein said controlling is performed *when power supply to a camera including the camera body is started*. Claim 16 is directed to a method that includes the steps of “determining whether display of an image captured is requested or not *when power supply to the camera is started*” and “when the display is requested, *driving a taking lens to a focus position where in-focus condition is substantially obtained for distant to close-range views.*” For at least the reasons given above, it is respectfully submitted that the Toyofuku and Hamada patents fail to teach or suggest the claimed combinations of features recited in claims 14 and 16, whether these documents are considered individually or in any combination.

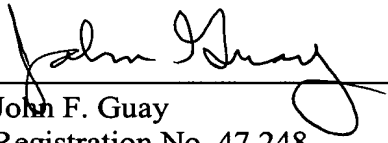
Dependent claims 2, 3, 13 and 15 each depend from one of claims 1 and 14 and are therefore allowable for the above reasons, and for the additional features recited.

For all the foregoing reasons, Applicants respectfully request reconsideration and withdrawal of the rejections of the pending claims. Prompt allowance of the application is earnestly solicited.

Respectfully submitted,

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Date: July 2, 2004